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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,867	02/23/2004	Kang Soo Seo	46500-000570/US	7081

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EXAMINER

ADEGEYE, OLUWASEUN

ART UNIT	PAPER NUMBER
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2481

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12/06/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/782,867	Applicant(s) SEO ET AL.	
	Examiner OLUWASEUN A. ADEGEYE	Art Unit 2481	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/23/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 3, 6 - 8, 24 - 25 and 28 - 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 3, 6 - 8, 24 - 25 and 28 - 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/23/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/17/2010, 07/16/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 24 and 25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 3, 6 – 8 and 24 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent and recent Federal Circuit decisions indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claims recite a series of steps or acts to be performed, the claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, a method of reproducing still picture data and audio data comprising decoding and outputting steps of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 3, 6 – 7, 24 – 25, and 28 – 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kashiwagi et al (US 2003/0138238 A1).

As to **claim 25**, Kashiwagi discloses an apparatus for reproducing still picture data and audio data from a recording medium (see [135]. The above paragraph discloses a recording medium M) (Fig. 3 discloses an apparatus for reproducing still picture data and audio data), comprising:

a decoding unit (2500) configured to decode the still picture data in a first stream file based on a first system time (STC), configured to output the decoded still picture data based on the first STC and presentation time stamps (PTSs) in the still picture data (see [784].”.... the video decoder synchronizer 32022 generates the video stream decoding start signal St89 based on the STC from the STC generator 32030 and the decoding time stamp DTS for starting video decoding supplied from the PTS/DTS extractor.....”), the first stream file not including audio data (see fig. 3. The above cited figure clearly discloses a different buffer for each stream), configured to decode the audio data in a second stream file based on a second STC, independent of the first STC (Paragraph 776 discloses generating STC for each decoder. “The STC generator 32030

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generates the system clock for each decoder") (Paragraph 21 also discloses independent STCs."....a system clock STC referenced by the signal processing decoders when decoding the first system stream and another system clock STC referenced by"), and configured to output the decoded audio data based on the second STC and the PTSs in the audio data(see [788].".....the audio decoder synchronizer 32035 generates the audio stream decoding start signal St93 based on the STC from the STC generator 32030 and the decoding time stamp DTS for starting audio decoding supplied from the PTS/DTS extractor").

Paragraph 148 discloses outputting video whereas paragraph 151 discloses outputting audio (see the last two lines of the cited paragraphs)

wherein the output of the decoded audio data is not synchronized with the output of the decoded still picture data when the decoded audio data is output with the decoded still picture data (see [0781]. The above cited paragraph discloses an OFF synchronization mode."....and no timing control is applied to synchronize the audio and video"), and

wherein the PTSs indicate entry points of the respective decoded still picture data and audio data (see [146] and [147]."....the synchronizer 2900 determines the decode start timing whereby each of the bit streams will be arranged in the correct sequence after decoding....."-see [147])). Also see paragraph 750.

Kashiwagi does not disclose decoding and outputting still picture data but he discloses decoding and outputting video data. It is well known in the art that video data consists of a plurality of still image data. Official notice is taken that the concept of

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decoding and outputting still picture data is well known and expected in the art. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a decoding unit configured to decode still picture data so as to provide a means for displaying individual still picture data, along with the stored audio data, because the ability to display still picture data would provide greater flexibility in regard to how visual information is displayed.

As to **claim 28**, Kashiwagi discloses the apparatus of claim 25, wherein the decoding unit is configured to decode the audio data and output the decoded audio data such that the decoded audio data is not synchronized with the outputting of the decoded still picture data (see [0781]. The above cited paragraph discloses an OFF synchronization mode.”....and no timing control is applied to synchronize the audio and video”).

As to **claim 29**, Kashiwagi discloses the apparatus of claim 25, further comprising:

a first STC generator (2902) configured to generate a first STC for the still picture data (see [731].” The STC generator 2902 generates the system clock for each decoder”) and

a second STC generator configured to generate a second STC for the audio data (see [731].” The STC generator 2902 generates the system clock for each decoder”).

Fig. 41 discloses an STC generator for each decoder.

(Paragraph 21 also discloses independent STCs."....a system clock STC referenced by the signal processing decoders when decoding the first system stream and another system clock STC referenced by")

As to **claim 30**, Kashiwagi discloses the apparatus of claim 29, wherein the first STC generator is configured to generate the first STC from program clock references (PCRs) in the still picture data; and

the second STC generator is configured to generate the second STC from PCRs in the audio data.

Paragraph 738 discloses PCR (SCR) used for calculating STC.

As to **claim 31**, this is the same as claim 25 only in that the limitation "the first decoder is configured to decode the still picture data and second decoder is configured to decode audio data" is additionally recited.

Kashiwagi discloses an audio decoder (3200) and a video decoder (3800) (see fig. 3)

As to **claim 32**, Kashiwagi discloses the apparatus of claim 31, wherein, the demultiplexer (2300) is configured to obtain the PTSs in the still picture data and the PTSs in the audio data (see [146]."The system decoder 2500 detects the presentation time stamp PTS and the decoding time stamp DTS of the smallest control unit in each bit stream....."), and configured to obtain first program clock references (PCRs) from the still picture data and second PCRs from the audio data (see [750]."The system clock reference SCR is time information indicating the pack transfer time, and is recorded with each pack.....").

As to **claim 1** grounds for rejecting claim 25 apply to claim 1 in its entirety.

As to **claim 2** grounds for rejecting claim 29 apply to claim 2 in its entirety.

As to **claim 3** grounds for rejecting claim 30 apply to claim 3 in its entirety.

As to **claim 6** grounds for rejecting claim 31 apply to claim 6 in its entirety.

As to **claim 7** grounds for rejecting claim 32 apply to claim 7 in its entirety.

As to **claim 24** grounds for rejecting claim 25 apply to claim 24 in its entirety.

5. Claims 8 and 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Kashiwagi as applied to claim 1 above, and further in view of Kato et al (US 2002/0164152 A1).

As to **claim 8**, Kashiwagi discloses the method of claim 1. However he does not disclose further comprising: reproducing at least one playlist file from the recording medium, the playlist including at least one playitem and at least one sub-playitem indicating an in-point and out-point of the stream file for reproducing the still picture data the at least one sub-playitem indicating an in-point and out-point of the second stream file from reproducing the audio data.

Kato discloses further comprising: reproducing at least one playlist file from the recording medium, the playlist including at least one playitem and at least one sub-playitem indicating an in-point and out-point of the stream file for reproducing the still picture data the at least one sub-playitem indicating an in-point and out-point of the second stream file from reproducing the audio data (see fig. 7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added the playitem and the sub-playitem of Kato to the

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apparatus of Kashiwagi to provide a recording medium for recording whereby the contents of data recorded on the recording medium and the replay information can be managed properly (see [008]).

As to **claim 33**, grounds for rejecting claim 8 apply to claim 33 in its entirety.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUWASEUN A. ADEGEYE whose telephone number is (571)270-1711. The examiner can normally be reached on Monday - Friday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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11/17/10

/O.A/

/Peter-Anthony Pappas/
Supervisory Patent Examiner, Art Unit 2481